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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20050527

Application Number: 09/560,067
Filing Date: April 27, 2000
Appellant(s): Brian M. Mattson

Brian M. Mattson
(Reg. No. 35,018)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal filed March 8, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(Assignee of record, *Patents+TMS, P.C.*)

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (Related appeal filed in divisional application 10/234,305.)

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(Claims 9-14, 21, 22, 24, 25, and 27-29 are pending, rejected, and appealed.)

(Claims 1-8, 15-20, 23, and 26 have been cancelled.)

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(No amendment after final has been filed.)

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

I. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website.

II. Claims 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website, as applied to claims 9-14 above, and further in view of Koether (US 5,875,430).

III. Claims 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke et al. (US 6,253,326).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

CyberDiner Internet Cafe Systems website		10/1998
Blue Ginger webpage at Boston Globe website		3/2000
5,875,430	Koether	2/1999
6,253,326	Lincke et al.	6/2001

(9) Grounds of Rejection

I. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website.

CyberDiner Internet Cafe Systems comprises a restaurant, the restaurant having personal computers connected to the Internet for providing Internet access to restaurant patrons (thereby enabling the patrons to access Internet websites), the restaurant therefore inherently having within it (at each patron's computer) an apparatus comprising: an input means and a transmission means, wherein the obvious, self-evident method of use is to input real-time information into the apparatus to be transmitted remotely from the restaurant (to the Internet) by the transmission means in real-time; a receiving means; a display means connected to the apparatus that displays the information; a processing means; an input means (information being

displayed simultaneously while it is input into the processing means); and, a network (to which the patron's computer is connected) remotely receiving the information from the apparatus, the network being the Internet; but CyberDiner Internet Cafe Systems, however, does not specifically disclose that the real-time information to be entered into the apparatus would comprise real-time information concerning the restaurant, such as a review of the restaurant, nor does it disclose posting the entered and transmitted real-time information at a website outside of the restaurant for viewing by persons outside of the restaurant.

However, the Blue Ginger webpage at the Boston Globe website shows information concerning a restaurant (reviews of the restaurant) that has been entered into the Internet and posted at the website by patrons of the restaurant, where it is stored and accessed by computer, but the information is not specifically disclosed as having necessarily been entered into the Internet and transmitted to the website while the restaurant patron was still in the restaurant.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used the system and method of CyberDiner simultaneously with the system and method of the Blue Ginger webpage at the Boston Globe (i.e., to view and post to a restaurant review page for the CyberDiner restaurant at the same site as, and comparable to, the Blue Ginger page, <http://ae.boston.com/dining/restaurant/122>, while using the Internet access at CyberDiner to do so), so as to post a review of the CyberDiner restaurant on the Internet using the Internet access of the CyberDiner establishment, in order to post the review as quickly as possible, while the dining experience was still fresh in the mind of the reviewer.

II. Claims 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website, as applied to claims 9-14 above, and further in view of Koether (US 5,875,430).

CyberDiner Internet Cafe Systems comprises a restaurant, the restaurant having personal computers (personal digital assistants) connected to a local area network (LAN), the local area network being connected to a wide are network (WAN), the wide area network being the Internet, for providing Internet access to restaurant patrons (thereby enabling the patrons to access Internet websites), as applied above in the rejection of claims 9-14, but the particular connection method(s) of the personal digital assistants of CyberDiner Internet Cafe Systems to the CyberDiner local area network, whether wired or wireless, is not disclosed.

However, Koether discloses a restaurant connecting various computer devices therein by means of a local area network, the restaurant's local area network being connected to a wide area network, the wide area network being the Internet, the devices thereby being able to access the Internet, and Koether indeed discloses that the connections of the local area network may be either wired or wireless, but, are preferably wireless (see, in particular, Figure 1 and the description thereof in column 5, lines 3-19).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system and method of CyberDiner, so as to use wireless connections for the local area network connecting the personal digital assistants, in accordance with the teachings of Koether, in order to make installation of the network easier.

III. Claims 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke et al. (US 6,253,326). See, in particular, Figures 1 and 3.

Lincke et al. disclose a system and method for providing real-time information regarding a restaurant, comprising: providing a portable apparatus 100 operated by a user, wherein the portable apparatus 100 has an input means, a wireless transmission means, and a display 101; providing a form 105 on the display 101 of the portable apparatus 100, wherein the form 105 includes information that the user implements to enter as the real-time information regarding the restaurant, wherein the real-time information includes features of the restaurant, including at least one of the food served at the restaurant, service at the restaurant, and ambiance of the restaurant (see, for example, Figure 3); inputting the real-time information regarding the restaurant into the portable apparatus by the user; processing the real-time information input by the user; and, transmitting the real-time information 305 input by the user to a destination 140 remote from the restaurant, but while Lincke et al. do disclose using the portable apparatus to enter the real-time information regarding the restaurant, they do not disclose doing so while at the restaurant.

However, to those of ordinary skill in the art, accessing the Internet while at a restaurant using a personal digital assistant or other portable computer is certainly a well known, hence obvious, step to follow, since many restaurants are even specially modified to facilitate such access for such devices (e.g., so-called "hot-spots," etc.).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lincke et al. so as to use the portable apparatus to perform the recited steps while at the restaurant, as is well known to do, in order to be able to obtain current information, pertinent to the user's current activities, in a timely fashion (i.e., to learn more about what the user was interested in and doing at the moment: patronizing the restaurant), and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 27, the portable wireless apparatus 100 of Lincke et al. is a personal digital assistant.

Regarding claims 28-29, the destination 140 of Lincke et al. is a website that is accessible using a portable wireless device.

(10) Response to Argument

At the outset, the examiner points out that appellant's "exhibits"--none of which are presumably necessary, as they are all purportedly documents already of record in this case--are, in any event, in some cases missing (Exhibits D and E, the two patents), or worse, as in the case of Exhibit C, *completely different from any references of record in this application.*

PLEASE TAKE NOTICE that the proper, applied "Blue Ginger" webpage is the Blue Ginger webpage at the Boston Globe website, "boston.com," (Cited on form 892 and included in Paper No. 7). Where appellant's "Blue Ginger" webpage exhibits came from is unknown.

I. Claims 9-14 are unpatentable under 35 U.S.C. 103(a) for being obvious over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website.

Claim 9 requires, and the *CyberDiner* and *Blue Ginger* references respectively show, *method steps* (i.e., verbs) comprising the following specific elements:

Claim 9	***CyberDiner***	***Blue Ginger***
Providing a first apparatus having an input means wherein the input means allows entry of real-time information by a patron of a restaurant;	*Providing* a first apparatus having an input means wherein the input means allows entry of real-time information by a patron of a restaurant (the express purpose for providing the equipment is for patrons to input real-time information);	*Providing* a first apparatus having an input means wherein the input means allows entry of information by a patron of a restaurant (all inherently required to operate as disclosed, but the information not necessarily entered in real-time);
Inputting the real-time information into the input means of the first apparatus;	*Inputting* the real-time information into the input means of the first apparatus (again, the express purpose in providing the equipment);	*Inputting* the information into the input means of the first apparatus (but not necessarily in real-time);
Transmitting the real-time information to a destination remote from the restaurant;	*Transmitting* the real-time information to a destination remote from the restaurant (the Internet);	*Transmitting* the information to a destination remote from the restaurant (the Boston Globe website);
*W*herein the real-time information includes information regarding the restaurant.	Does not disclose this caveat.	*W*herein the information includes information regarding the restaurant.

Notice that *CyberDiner* anticipates all aspects of claim 9 except for the nature of the particular non-functional descriptive material being entered by the restaurant patron in real-time as the real-time information.

Notice too, that *Blue Ginger* also anticipates all aspects of the claims except that the information concerning the restaurant is not necessarily entered in real-time. Neither, though, is it precluded from being entered in real-time.

Regarding the combination of these two references, note that many individuals have no Internet access available at their home or workplace, and *rely* on publicly available Internet terminals such as those at Internet cafes and libraries. Were such an individual to use a website such as the Boston Globe website while accessing the Internet through their normal Internet access means comprising an Internet cafe, and use the website to post a review of that cafe which they patronize and thus are in a position to review, the same as other reviewers at that website--a scenario by no means improbable--the individual would *necessarily* be performing all steps of appellant's claimed method. It hardly seems appropriate that such a scenario should be prevented/barred/banned by virtue of the government granting appellant a monopoly to performing such self-evident steps.

Regarding the arguments provided be appellant, note that appellant merely argues against the reference individually (i.e., that since neither reference fully anticipates the claim, the claims are therefore patentable), which arguments utterly ignore the actual rejection applied (i.e., obviousness). With respect to arguments against the references individually, note that

one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that "real-time" is faster than "as quickly as possible," it is the finding of the examiner, as trier-of-fact, that "real-time" is indeed "as quickly as possible."

Regarding the argument that a webpage such as that of *Blue Ginger* is not a "display means to be viewed by a patron outside of the restaurant," it is the finding of the examiner, as trier-of-fact, that a webpage such as that of *Blue Ginger* is indeed a "display means to be viewed by a patron outside of the restaurant."

Regarding the argument that with appellant's method it becomes possible for potential patrons to make better informed decisions regarding a restaurant because the reviews, being posted in real-time, are more recent than reviews posted in less-than-real-time with *Blue Ginger*, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Moreover, the fact that an invention may produce a more efficient and more economical method of accomplishing result does not constitute invention. *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69. Lastly on this point, the argument is deemed specious, because there is nothing to guarantee that anyone is posting a review at the precise instant that another person is looking for it. A review posted with appellant's invention may

well sit for six weeks before anybody actually looks at it, thereby utterly negating any potential advantage of being posted in real-time, as opposed to a day, a week, or even a month later.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, many individuals have no Internet access available at their home or workplace, and *rely* on publicly available Internet terminals such as those at Internet cafes and libraries. It would be blatantly obvious/self-evident for such an individual to use their normal Internet access means of an Internet cafe to access a website such as the Boston Globe website, since they would have no other means to do so. Using that website to post a review of that cafe which they patronize and thus are in a position to review (as opposed to any other restaurant which they patronize and thus are in a position to review) is a further obvious/self-evident use of that website, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

II. Claims 21, 22, and 24 are unpatentable under 35 U.S.C. 103(a) for being obvious over CyberDiner Internet Cafe Systems, in view of the Blue Ginger webpage at the Boston Globe website, as applied to claims 9-14 above, and further in view of Koether (US 5,875,430).

Relative to claim 9, claim 21 does not require that the information be entered in "real-time," but adds that the device is "located in the restaurant" and is "wireless."

Clearly, the *CyberDiner* device is located in the restaurant, but it is not disclosed as being wired or wireless (obviously, each of the devices in *CyberDiner* must be at least one or the other). *Koether* overcomes this shortcoming however, because *Koether* discloses a restaurant connecting various computer devices therein by means of a local area network, the restaurant's local area network being connected to a wide area network, the wide area network being the Internet, the devices thereby being able to access the Internet, and *Koether* indeed discloses that the connections of the local area network may be either wired or wireless, but preferably are wireless (see, in particular, Figure 1 and the description thereof in column 5, lines 3-19).

Regarding the argument that *CyberDiner* teaches away from wireless because it requires "a place to put it and a place to plug it in," this is but another specious argument by appellant, since the *CyberDiner* reference to plugging it in refers merely to power and Internet connection for the central server/gateway, and has nothing whatsoever to do with the connections of the individual client devices within the restaurant to the central server/gateway of the restaurant.

The argument that *Koether* does not teach inputting information regarding the restaurant is but another invalid argument against the references individually, since *Koether* was not described as showing that element of the claims. *Koether* was relied upon by the rejection merely for its teaching of connecting client devices within a restaurant to a central server/Internet gateway within the restaurant.

Regarding the arguments against the references individually, note that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument that *CyberDiner* does not disclose that the device, into which the information is entered, is a "personal digital assistant," it is the finding of the examiner, as trier-of-fact, that the device in *CyberDiner* is indeed considered a "personal digital assistant," since the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

III. Claims 25 and 27-29 are unpatentable under 35 U.S.C. 103(a) for being obvious over Lincke et al. (US 6,253,326).

Claim 25 requires, and the *Lincke et al.* reference shows, *method steps* (i.e., verbs) comprising the following specific elements:

Claim 25	***Lincke et al.***
Providing a portable apparatus *operated* by a user, wherein the portable apparatus has an input means, a wireless transmission means, and a display;	*Providing* a portable apparatus (100) *operated* by a user, wherein the portable apparatus has an input means, a wireless transmission means, and a display (101);
Providing a form on the display of the portable apparatus, wherein the form includes information that the user implements to *enter* as real-time information regarding the restaurant **at the restaurant**;	*Providing* a form (105) on the display (101) of the portable apparatus (100), wherein the form includes information that the user implements to *enter* as real-time information regarding the restaurant (not necessarily at the restaurant);
Wherein the real-time information includes features of the restaurant, including at least one of the food served at the restaurant, the service at the restaurant, and the ambiance of the restaurant;	Wherein the real-time information includes features of the restaurant, including at least one of the food served at the restaurant, the service at the restaurant, and the ambiance of the restaurant (Figure 3);
Inputting the real-time information **at the restaurant** regarding the restaurant into the portable apparatus by the user;	*Inputting* the real-time information regarding the restaurant into the portable apparatus by the user (not necessarily at the restaurant);
Processing the real-time information input by the user; and,	*Processing* the real-time information input by the user; and,
Transmitting the real-time information input by the user to a destination remote from the restaurant.	*Transmitting* the real-time information (305) input by the user to a destination (140) remote from the restaurant.

Note that the *only* element of the claims missing from *Lincke et al.* is the user inputting the information while at the restaurant, as opposed to being somewhere else. However, to those of ordinary skill in the art, accessing the Internet while at a restaurant using a personal digital assistant or other portable computer is certainly a well known, hence obvious, step to follow, since many restaurants (e.g., Starbuck's) are even specially modified expressly to facilitate such access for such devices (e.g., so-called "hot-spots," etc.). Thus, merely reciting that the information be entered within a restaurant/Starbuck's, as opposed to *any other convenient location*, falls vastly short of being patentably distinct, since the modification could be performed readily and easily by *any* person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding the argument that *Lincke et al.* fails to disclose entering the information at the restaurant (emphasis in the original), the argument is spurious for being non-responsive to the applied rejection, since the rejection stated as much, and addressed the cited deficiency.

Regarding arguments against the references individually, note that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

(5-27-05)

Gerald J. O'Connor
Primary Examiner
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GJOC

May 27, 2005

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